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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 10/17/2003

JP

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,357

Applicant(s)

WEINSTEIN, KEITH

Examiner

John P. Sheehan

Art Unit

1742

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Withdrawal of the Final Rejection

1. Applicant is advised that the Final Rejection mailed August 19, 2003 has been withdrawn. The amendment submitted September 30, 2003 has been entered. The claims are rejected as follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3 to 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claim 1, lines 2 to 4, the language, "an alloy composition selected from a group" (emphasis added by the Examiner) used to introduce the subsequently recited Markush group is indefinite. The term "alloy" is used in this expression, however, the members of the Markush are not alloys but rather are elements. Further, the claim language, "selected from a group consisting essentially of" (lines 2 and 3, emphasis added by the Examiner) used to introduce the Markush group is not clear in that the use of the term "essentially" leaves the Markush group open ended as to what if any other elements are included in the group. If

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applicants is attempting to claim a white gold composition comprising 24k gold and an alloy composition consisting essentially of copper, silver, zinc, manganese, tin, cobalt, silicon/copper and boron/copper then it is suggested that applicants delete the phrase, "selected from a group" (lines 2 and 3).

II In each of claims 3, 6, and 8 to 14 it is not clear whether the proportion preceding the phrase, "tin, cobalt, silicon/copper and boron/copper" (see claims 3 and 6, line 2; claims 8, 10 and 12, the last 2 lines; and claims 9, 11, 13 and 14, the last line) refers to each of "tin, cobalt, silicon/copper and boron/copper" that is, each of "tin, cobalt, silicon/copper and boron/copper" is individually present in the recited amount or whether the recited proportion refers to the cumulative proportion for the total of the "tin, cobalt, silicon/copper and boron/copper" content. It is noted that this rejection was previously made in the Office action mailed April 10, 2003 and that although applicant did not specifically respond to this rejection it had inadvertently been dropped in the subsequent Office action mailed August 19, 2003.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1 and 3 to 7 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Vincent (US Patent No. 6,342,182), Tuccillo (US Patent No. 3,981,723), Olson et al. (Olson, US Patent No. 3,663,217) or Abbott (US Patent No. 3,661,569).

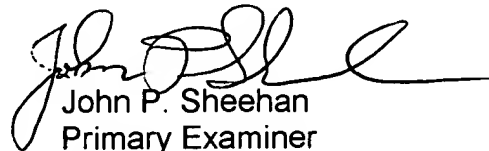
Each of the references teaches at least one specific example alloy having a composition that is encompassed by the instant claims (Vincent, columns 3 and 4, Tables I and II; Tuccillo, Examples 1 to 13; Olson, columns 3 and 4, the table; and Abbott, column 3, the table).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


John P. Sheehan
Primary Examiner
Art Unit 1742

jps